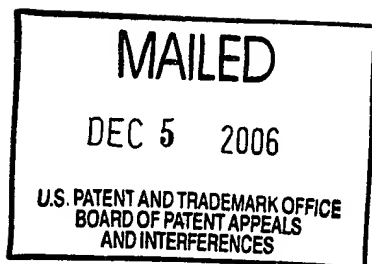


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte EDELBERT KONIG

Application 09/981,847

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on November 6, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

An examination of the Image File Wrapper (IFW) reveals that an Appeal Brief was filed on December 27, 2005.

37 CFR § 41.37(c)(1)(v) (2005) reads as follows:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

....

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The “Summary of claimed subject matter” appearing on pages 2-8 of the Appeal Brief filed December 27, 2005 is deficient because it does not map the independent claims to the specification. Correction is required.

In addition, an Information Disclosure Statement (IDS) was filed on October 18, 2001. While the foreign patent documents were considered, it is not apparent from the record whether the examiner considered the U.S.

patent. A communication notifying appellant of the Primary Examiner's decision regarding consideration of U.S. Patent No. 6,009,467 is required.

Finally, it is noted that while the Examiner's Answer mailed March 15, 2006, lists the Sridhar (6,098,108), Collin et al (WO 0049501) and McGregor ("Designing User Interface Tools for the X Window System") references on page 3 under the caption "(8) Evidence Relied Upon", the claim rejections are listed as follows:

Claims 1 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sridhar (US Patent 6,098,108) in view of Colin, Zeev (International Publication Number WO 00/49501, hereinafter referred to as Sridhar and Collin respectively [page 3]; anticipated by US Patent No. 5,754,540 by Liu et al. [page 3];

Claims 3-7 and 10-1 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sridhar in view of Collin as applied to claim 1 above, and further in view of Waite et al. (US Patent 4,688,170) [page 7];

Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sridhar in view of Collin and further in view of Waite, as applied to claims 3-7 above, and further in view of Official Notice [page 10]; and

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sridhar and Collin, as applied to claim 1, and further in view of Kraslavsky et al. (US Patent 5,537,626), hereinafter referred to as Kraslavsky [page 11].

The Examiner's Answer mailed March 15, 2006 is deficient because the "Evidence Relied Upon" section does not include the Waite, "Official Notice" and Kraslavsky references. Correction is required.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) for notification to appellant to submit a substitute Appeal Brief which corrects the "Summary of Claimed Subject Matter";
- 2) for consideration of the substitute Appeal Brief;
- 3) for consideration of the U.S patent included in the IDS filed October 18, 2001, and written notification to appellant regarding the Primary Examiner's decision;
- 4) for submission of a revised Examiner's Answer which corrects the "Evidence Relied Upon" section; and
- 5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

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Application 09/981,847

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